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NXP, B.V. NXP INTELLECTUAL PROPERTY & LICENSING M/S41-SJ 1109 MCKAY DRIVE SAN JOSE, CA 95131			NIGH, JAMES D	
			ART UNIT	PAPER NUMBER
			3685	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ip.department.us@nxp.com

### Office Action Summary

**Application No.**

10/577,087

**Applicant(s)**

PRZYBILLA, HENRIK

**Examiner**

JAMES D. NIGH

**Art Unit**

3685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This communication is in response to amendments and remarks filed on 30 October 2009.

#### ***Claim Status***

2. Claims 1-7 have been cancelled. Claims 8-10 have been amended. Claims 11-27 have been added. Claims 8-27 are currently pending and are presented for examination on the merits.

#### ***Response to Amendment***

3. Claim 8 recites a DRM system and then recites "DRM server device that issues digital rights", "DRM user device that receives the DROs from the DRM server device", a plurality of DRM client devices "...that stores the associated DDOs on the basis of DROs stored in the DRM user device", "that authenticates the DRM client device by the DRM user device". These are all recitations of intended use and do not distinguish the claimed invention from the prior art. While functional language may be used in claims it is structure, not function that will distinguish claims from the prior art "While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone", MPEP 2114; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997). Claims 9, 11-14 and 16-19 recite similar recitations which also do not distinguish the claimed invention from the prior art.

4. Claim 15 recites " wherein each DRO represents exactly one permission to use the associated DDO". Claim 20 recites similar language. This is non-functional

descriptive material "Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability .... [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate" *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II, "We conclude that when the prior art describes all of the claimed structural and functional relationships between descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the claimed descriptive material is non-functional and will not constitute a sufficient difference from the prior art to establish patentability", *Ex parte Halligan*, 89 USPQ2d 1355 (Bd. Pat. App. & Int. 2008).

5. Claim 10 is directed towards non-statutory subject matter. The claim recites steps of authentication which as claimed "authenticating the DRM user device to a DRM server device" and "authenticating a plurality of DRM client devices to said DRM user device" which does not recite a particular machine as performing the authentication; in the broadest reasonable interpretation the authentication would be extra-solution activity. In addition as recited no physical transformation is occurring. A suggested construction would be "authenticating, by a DRM server device, a DRM user device" and "authenticating, by a DRM user device, a plurality of DRM client devices. The claim also recites "determining, with the DRM user device..." which again in the broadest reasonable interpretation could be extra-solution activity. A recommended construction would be "determining, by the DRM user device..." Claim 10 also recites " transferring

usage rights from said DRM user device to said DRM client devices..." which again in the broadest reasonable interpretation could be extra solution activity. A recommended construction would be "transferring, by the DRM user device, usage rights to said DRM client devices..."

### ***Response to Arguments***

6. Applicant's argument with regard to the 35 U.S.C. § 101 rejection of the claims has been fully considered but is only partly persuasive. As recited claim 10 does not recite a particular machine as performing the method and in the broadest reasonable interpretation could represent extra-solution activity. For the benefit of the Applicant Examiner has provided suggested claim language in the response to Amendment which if incorporated would overcome the rejection.

7. Applicant's argument with regard to the 35 U.S.C. § 112, 2<sup>nd</sup> paragraph has been fully considered and is not persuasive. In claim 8 for example structure that is recited as being part of a particular device is also being recited as manipulated by other devices within the claimed system. As such the scope of the claim cannot be ascertained.

In addition claim 8 recites "a plurality of DRM client devices granted permission by the DRM user device..." and then further recites "a rights interface that requests access to the DROs... after authentication to the DRM user device." The claim is reciting an interaction process between the client device and the user device. It has been held that a claim that recites both an apparatus and a method for using said apparatus is indefinite under section 112. Therefore, as claim 5 possesses such a

deficiency it is rejected for failing to particularly point out and distinctly claim the invention (*IPXL Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990)).

Claim 9 recites "a second interface that receives the DROs from the DRM server device after the DRM user device is authenticated and grants usage rights for the associated DDO stored on an authenticated DRM client device". Applicant is describing that the structure only receives the DROs from the server subsequent to an authentication of the DRM user device, which again is a process within a structural claim. It has been held that a claim that recites both an apparatus and a method for using said apparatus is indefinite under section 112. Therefore, as claim 5 possesses such a deficiency it is rejected for failing to particularly point out and distinctly claim the invention (*IPXL Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990)).

8. Applicant's argument with regard to the 35 U.S.C. § 102 (e) and 103 (a) rejection of the claims has been fully considered but is moot in view of the new ground(s) of rejection. However Examiner wishes to comment on a remark made by Applicant. Applicant recites that "Messerges warns that security of content in a domain is potentially threatened if users can remotely register devices into a domain over a long distance. Thus, Messerges enforces a "close proximity" requirement that teaches away from the claimed subject matter". A review of Applicant's disclosure regarding the relationship between the user device and the client devices reveals only two types of communication as disclosed. The first as disclosed in paragraph 0058 of the published

version of the specification recites a smart card, which is recited in paragraph 0062 "A smart card as a DRM user unit can interact with a terminal or the DRM client unit via a contact or a contactless interface". The second communication is recited in paragraph 0063 recites "The interfacing between the mobile terminal as the DRM user unit and a DRM client unit will preferably be a contactless interface like e.g. ISO 14443 or NFC (near field communication)". These interfaces recite either direct physical contact (disclosed by Messerges with regard to a smart card) or as Messerges discloses "close proximity". Thus Applicant has neither claimed nor recited any structure meeting the requirements of 35 U.S.C. § 112, 1<sup>st</sup> paragraph that distinguishes the claimed invention in this regard from the disclosure of Messerges. Therefore the "teaches away" argument must be rendered as invalid and without merit.

***Claim Rejections - 35 USC § 101***

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. **Claims 10 and 21-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**
11. Claim 10 recites a method however none of the method steps recite a particular machine as performing the steps; in addition no physical transformation of matter is occurring. Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class

(such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

In this particular case, claim 10 fails prong (1) because the "tie" (e.g. authenticating the DRM user device to the DRM server device) is representative of extra-solution activity. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

12. Claims 21-27 are also rejected as being dependent upon claim 10.

***Claim Rejections - 35 USC § 112***

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.



**14. Claims 8-9 and 16-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

15. Claim 8 recites a system, further recites a DRM client device and then recites that the DRM client device comprises "a first authentication unit that authenticates the DRM client device by the DRM user device". As such the scope of the claim cannot be ascertained as the claim recites that structure that is part of the DRM client device is being performed by the DRM user device "An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed...", *In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989).

16. In addition claim 8 recites "a plurality of DRM client devices granted permission by the DRM user device..." and then further recites "a rights interface that requests access to the DROs... after authentication to the DRM user device." The claim is reciting an interaction process between the client device and the user device. It has been held that a claim that recites both an apparatus and a method for using said apparatus is indefinite under section 112. Therefore, as claim 5 possesses such a deficiency it is rejected for failing to particularly point out and distinctly claim the invention (*IPXL Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990)).

17. Claim 9 recites "a second interface that receives the DROs from the DRM server device after the DRM user device is authenticated and grants usage rights for the

associated DDO stored on an authenticated DRM client device". Applicant is describing that the structure only receives the DROs from the server subsequent to an authentication of the DRM user device, which again is a process within a structural claim. It has been held that a claim that recites both an apparatus and a method for using said apparatus is indefinite under section 112. Therefore, as claim 5 possesses such a deficiency it is rejected for failing to particularly point out and distinctly claim the invention (*IPXL Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990)).

18. Claims 11-15 are also rejected as being dependent upon claim 8.

19. Claims 16-20 are also rejected as being dependent upon claim 9.

***Claim Rejections - 35 USC § 103***

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. **Claims 8-11, 13-16, 18-20 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Messerges (U.S. Patent PG Publication 2004/0103312, hereinafter referred to as Messerges) in view of Singer et al. (U.S. Patent PG Publication 2004/0117440, hereinafter referred to as Singer).**

22. As per claim 8

Messerges discloses a DRM server device that issues digital rights objects (DROs) representing permission to use associated digital data objects (DDOs) (0018,

0021, 0025-0026, 0035). The language "that issues..." is intended use and does not distinguish the claimed invention from the prior art.

Messerges discloses a DRM user device that receives the DROs from the DRM server device (0021, 0024-0026). The language "that receives..." is intended use and does not distinguish the claimed invention from the prior art.

Messerges does not explicitly disclose a plurality of DRM client devices granted permission by the DRM user device to use a specific DDO. Singer teaches a plurality of DRM client devices granted permission by the DRM user device to use a specific DDO (0030-0031, 0059-0060). The language "that grants..." is intended use and does not distinguish the claimed invention from the prior art.

Singer teaches a data storage unit that stores the associated DDOs on the basis of DROs stored in the DRM user device (0030-0031, 0059-0060). The language "that stores..." is intended use and does not distinguish the claimed invention from the prior art.

Singer teaches an authentication unit and the authentication of the DRM client device by the DRM user device (0028, 0036, 0041, 0077-0079, 0083-0084, 0100-0101). The language "that authenticates..." is intended use and does not distinguish the claimed invention from the prior art.

Singer teaches a rights interface that requests access to the DROs associated with the DDOs stored in said data storage unit after authentication to the DRM user device (0042, 0095, 0101, 0112-0117). The language "that requests..." is intended use and does not distinguish the claimed invention from the prior art.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the domain-based digital rights management system of Messerges with the media network environment of Singer for the purpose of allowing users to access digital content through various devices in multiple locations while preventing uncontrolled and unauthorized copying and resulting potential problems.

23. As per claim 9

Messerges discloses a plurality of DRM client devices that store digital data objects (DDOs) (0009, 0018, 0026, 0035). The language "that store..." is intended use and does not distinguish the claimed invention from the prior art.

Messerges discloses a DRM server device that issues digital rights objects (DROs) representing permission to use associated DDOs (0018, 0021, 0024-0026, 0031, 0035). The language "that issues..." is intended use and does not distinguish the claimed invention from the prior art.

Messerges discloses a DRM user device that receives the DROs from the DRM server device (0009, 0018, 0026, 0035). The language "that receives..." is intended use and does not distinguish the claimed invention from the prior art.

Messerges discloses a DRM server device authenticating a DRM user device (0032-0033)

Messerges does not explicitly disclose that the DRM user device comprises an authentication unit that authenticates the plurality of DRM client devices. Singer teaches that the user unit authenticates the plurality of DRM client devices (0028, 0036, 0041,

0077-0079, 0083-0084, 0100-0101). The language "that authenticates..." is intended use and does not distinguish the claimed invention from the prior art.

Singer teaches a DRM user device comprising a rights storage unit that stores DROs received from the DRM server device (0021, 0024-0026, 0030-0032, 0037, 0059, 0114-0115). The language "that stores..." is intended use and does not distinguish the claimed invention from the prior art.

Singer teaches wherein said DROs are accessed by an authenticated DRM client to get permission to use an associated DDO stored on said DRM client device (0113-0117). However this is simply non-functional descriptive material "Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability .... [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate" *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II, "We conclude that when the prior art describes all of the claimed structural and functional relationships between descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the claimed descriptive material is non-functional and will not constitute a sufficient difference from the prior art to establish patentability", *Ex parte Halligan*, 89 USPQ2d 1355 (Bd. Pat. App. & Int. 2008).

Singer teaches an interface that receives the DROs from the DRM server device (0021, 0024-0026) and grants usage rights for the associated DDO stored on an

authenticated DRM client device (0113-0117). However the recitation "that receives... and grants..." is intended use and does not distinguish the claimed invention from the prior art.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the domain-based digital rights management system of Messerges with the media network environment of Singer for the purpose of allowing users to access digital content through various devices in multiple locations while preventing uncontrolled and unauthorized copying and resulting potential problems.

24. As per claim 10

Messerges discloses a DRM server device authenticating a DRM user device (0032-0033)

Messerges discloses a DRM server device that transfers digital rights objects (DROs) (0018, 0021, 0024-0026, 0031, 0035). However the language "to transfer a requested DRO from said DRM server device to said DRM user device following successful authentication" is intended use and does not distinguish the claimed invention from the prior art.

Messerges does not explicitly disclose client devices being authenticated by a user device. Singer teaches an authentication unit and the authentication of the DRM client device by the DRM user device (0028, 0036, 0041, 0077-0079, 0083-0084, 0100-0101).

Singer teaches the DRM user device determining whether to grant permission to use a specific DDO to different DRM client devices (0077, 0085, 0087, 0113-0117).

Singer teaches when permission is granted, transferring usage rights from said DRM user device to said DRM client devices after successful authentication to permit use of the specific DDO (0077, 0085, 0087, 0113-0117). However the language following the recitation "when permission is granted" is reciting an optional step as if permission is not granted the step will not be performed (MPEP §2106 II C, "Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation")

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the domain-based digital rights management system of Messerges with the media network environment of Singer for the purpose of allowing users to access digital content through various devices in multiple locations while preventing uncontrolled and unauthorized copying and resulting potential problems.

25. As per claim 11

Singer teaches the user device having authentication capability (0028, 0036, 0041, 0077-0079, 0083-0084, 0100-0101) and revocation lists (0114-0115).

26. As per claim 13

Messerges discloses a DRM server device authenticating a DRM user device (0032-0033)

27. As per claims 14 and 24

Messerges discloses a DRM user device that receives the DROs from the DRM server device (0021, 0024-0026) and authentication by the server (0032-0033).

Singer teaches an authentication unit and the authentication of the DRM client device by the DRM user device (0028, 0036, 0041, 0077-0079, 0083-0084, 0100-0101).

Singer teaches an interface that grants access to the DROs associated with the DDOs stored in said data storage unit after authentication to the DRM user device (0042, 0095, 0101, 0112-0117).

28. As per claims 15, 20 and 25

Messerges, while disclosing that rights objects are permissions to use the associated DDO (0021, 0026, 0030, 0035) does not explicitly disclose that each DRO represents exactly one permission to use the associated DDO; however this is non-functional descriptive material and is not entitled to patentable weight.

29. As per claim 16

Singer teaches an authentication unit and the authentication of the DRM client device by the DRM user device (0028, 0036, 0041, 0077-0079, 0083-0084, 0100-0101).

Singer teaches revocation lists (0114-0115).

30. As per claim 18

Messerges discloses a DRM server device authenticating a DRM user device (0032-0033)

31. As per claims 19 and 26

Singer teaches a limited number of supported clients (0205).

32. **Claims 12, 17 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Messerges in view of Singer and in further view of Evans et al. (U.S. Patent PG Publication 2003/0236978, hereinafter referred to as Evans).**



33. As per claim 12

Neither Messerges nor Singer explicitly disclose updating a revocation list remotely. Evans teaches remote updating of a revocation list (0059, 0066, 0089, 0144, 0149).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the domain-based digital rights management system of Messerges with the media network environment of Singer further with the secure media path method of Evans for the purpose of providing architectures infrastructure where layers are required to be trusted, thereby allowing untrusted applications to play protected content without knowledge of it being protected.

34. As per claim 17

Neither Messerges nor Singer explicitly disclose updating a revocation list remotely. Evans teaches remote updating of a revocation list (0059, 0066, 0089, 0144, 0149).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the domain-based digital rights management system of Messerges with the media network environment of Singer further with the secure media path method of Evans for the purpose of providing architectures infrastructure where layers are required to be trusted, thereby allowing untrusted applications to play protected content without knowledge of it being protected.

35. As per claim 21

Neither Messerges nor Singer disclose storing a revocation list of DRM client units in the DRM server device, wherein a second authentication unit in the DRM user device checks the revocation list during authentication of each DRM client. Evans teaches storing a revocation list of DRM client units in the DRM server device, wherein a second authentication unit in the DRM user device checks the revocation list during authentication of each DRM client device (0059, 0066, 089, 0144, 0149).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the domain-based digital rights management system of Messerges with the media network environment of Singer further with the secure media path method of Evans for the purpose of providing architectures infrastructure where layers are required to be trusted, thereby allowing untrusted applications to play protected content without knowledge of it being protected.

36. As per claim 22

Evans teaches using the DRM server device to update the revocation list stored in the DRM user device (0059, 0066, 089, 0144, 0149).

37. As per claim 23

Evans does not explicitly teach performing mutual authentication of the DRM server device and the DRM user device; however as Evans teaches distributed authentication at various levels of the chain with authenticators (Abstract, 0010, 0024, 0090) a predictable result (*KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)) of Evans would be the installation of authenticators at both the DRM server device and the DRM user device to authenticate each other for the purpose of providing

architectures infrastructure where layers are required to be trusted, thereby allowing untrusted applications to play protected content without knowledge of it being protected.

**38. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Messerges in view of Singer and in further view of Stefik et al. (U.S. Patent 5,629,980, hereinafter referred to as Stefik).**

39. As per claim 27

Neither Messerges nor Singer teach that a DRO can be transferable. Stefik teaches transferable DROs (Abstract, Figure 15, 35:1-29).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the domain-based digital rights management system of Messerges with the media network environment of Singer further with the system for controlling the distribution of digital works of Stefik for the purpose of allowing the owner of a digital work to attach usage rights to the work.

Please note:

A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicant(s) are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See *e.g.* MPEP §2106 II C: "Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim

limitation. [Emphasis in original.]; and *In re Johnston*, 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006) ("As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.").

### ***Conclusion***

40. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES D. NIGH whose telephone number is (571)270-5486. The examiner can normally be reached on Monday-Thursday 6:45-5:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt II can be reached on 571-272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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